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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,345	04/03/2006	Naoki Hori	067471-0109	8864
53080 7590 09/30/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, NW WASHINGTON, DC 20005-3096				
EXAMINER				
BUTCHER, BRIAN M				
ART UNIT		PAPER NUMBER		
2627				
MAIL DATE		DELIVERY MODE		
09/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,345

Applicant(s)

HORI ET AL.

Examiner

BRIAN BUTCHER

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-893)
Paper No(s)/Mail Date 03 April 2006
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This application is a 371 of PCT/JP04/14980, filed on 10/04/2004.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d) or (f).

The certified copy of the priority documents have been received in this National Stage Application from the International Bureau (PCT Rule 17.2(a)).

The foreign document identifies as:

JP 2003-345417, filed on 10/03/2003.

Specification

The disclosure is objected to because of the following informalities: On **page 9**, **line 10**, and on **page 10**, **line 15**, "**Fig. 6**" appears to need a change to "**Fig. 7**". Appropriate correction is required.

The disclosure is objected to because of the following informalities: On **page 11**, **line 3**, "**Fig. 3**" appears to need a change to "**Figures 3A and 3B**". Appropriate correction is required.

The disclosure is objected to because of the following informalities: On **page 24**, **line 20**, "**driver 6**" appears to need a change to "**driver 7**". Appropriate correction is required.

The disclosure is objected to because of the following informalities: On **page 26**, **lines 5 - 6**, **"DF-DAC circuit 52"** appears to need a change to **"DF-DAC circuit 11"**. Appropriate correction is required.

Drawings

Figures 7 – 11, 12A, and 12B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because **Figure 4 includes a step S203 which is labeled "S2003"**. Also, **Figure 7 includes a circuit block 11 labeled "DE-DAC" where "DF-DAC" is disclosed in the specification (page 25, line 6)**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be

canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **Figures 11, 12A, and 12B include the reference numeral "900" which is not recited in the specification.** Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. **Claim 9** is not patent eligible subject matter because the claimed invention does not fall within one of the four statutory categories of a process, machine, manufacture, or composition of matter.

Although closely related, a program is not a process and does not fall within the specific statutory category of a process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2 and 4 - 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanji (United States Patent Application Publication US 2001/0013269 A1), hereinafter referenced as Tanji.

Regarding **claim 1**, Tanji discloses a method and apparatus for storing audio data that reads on the playback device claimed. Tanji discloses "A playback device having a storage unit" (page 3, paragraph [0022], and figure 3 item 60) , "a playback unit operable to play back audio data stored in the storage unit" (page 4, paragraph [0026], lines 13 - 17, and figure 3 item 38 'DSP'), "a control unit (page 3, paragraph [0022], lines 9 – 13, and figure 3 items 12, 14) operable to store, in the storage unit, identification information of the audio data and specifying information specifying a storage location of the identification information, and sequentially store the audio data for playback in the remaining area of the storage unit (page 6, paragraphs [0037] [0038] 'song management data' 'sound data' , and figure 3 1, 5, 6A - 6D).

Regarding **claim 2**, Tanji discloses everything claimed as applied above (see claim 1), in addition Tanji discloses "an audio data reading unit operable to read the audio data from a recoding medium that is loaded in the playback device and contains a plurality of pieces of audio data and plurality of pieces of identification information of the respective pieces of the audio data; an identification information reading unit operable to read the identification information from the recording medium" (page 4, paragraph [0027], lines 9 -19 and figure 3 items 14, 56, 70, 72 The 'CPU 14', the 'bus 56', the 'interface 70', and the 'optical disk device 72' work as a whole to create both "an audio data reading unit" and "an identification information reading unit") , "a designating unit operable to designate, from among the plurality of pieces audio data, a piece of audio data for playback" (page 3 paragraph [0022] lines 13 – 18 page 3 paragraph [0023] lines 19 - 24, pages 4 - 5 paragraph [0030] lines 22 – 32, and figure 3 items 16, 20),

"wherein the control unit is operable to generate specification information based on the identification information read by the identification information reading unit, and after storing the identification information and the specifying information to the storage unit, cause the audio data reading unit to read part of the designated piece of audio data, and store the read part to the storage unit" (page 6, paragraph [0037], lines 16 – 54, and figure 5 The 'song management data' includes location information derived from the identification information that is stored in a section reserved in the memory of the 'HDD 60').

Regarding **claim 4**, Tanji discloses everything claimed as applied above (see claim 2), in addition Tanji discloses "wherein the control unit is operable to control the audio data reading unit, so that the audio data is sequentially read ahead of a current playback point and stored to the storage unit prior to playback by the playback unit" (page 3, paragraph [0023], lines 39 - 42 and page 5, paragraph [0031], lines 14 – 17 'DMA').

Regarding **claim 5**, Tanji discloses everything claimed as applied above (see claim 1), in addition Tanji discloses "wherein the control unit is operable to store the identification information and the specifying information in a limited amount not occupying a storage capacity of the storage unit exceeding a predetermined percentage" (page 6, paragraph [0037], lines 16 -20, and figures 1, 5 'FIXED CAPACITY' The 'fixed storage capacity' is a fixed or predetermined percentage of the storage unit HDD (60)).

Regarding **claim 6**, Tanji discloses everything claimed as applied above (see claim 1), in addition Tanji discloses "wherein the identification information is a file name of the audio data" (page 6, paragraph [0037], lines 21 -23, 'name and date of creation of the song')

Regarding **claim 7**, Tanji discloses everything claimed as applied above (see claim 1), in addition Tanji discloses "wherein the audio data is compressed using a predetermined compression format" (page 7, paragraph [0040], lines 31 - 36, 'compressed or coded format')

Regarding **claim 8**, Tanji discloses a method and apparatus for storing audio data that reads on the playback method claimed. Tanji discloses "a playback step of playing back audio data stored in the recoding medium" (page 2 and paragraph [0009]), "a control step of storing, in the recoding medium, identification information of the audio data and specifying information specifying a storage location of the identification information, and sequentially store the audio data for playback in remaining space of the recoding medium" (page 2, paragraphs [0012] , and lines 1 -11 'step of performing control for sequentially storing the audio data' 'step of performing control for sequentially storing the song management data').

Regarding **claim 9**, Tanji discloses a method and apparatus for storing audio data that reads on the computer program claimed. Tanji discloses "A computer program for causing a playback device having a recording medium to perform playback processing, . . . a playback step . . . a control step" (see claim 8 above and page 2, paragraph [0013] lines 3 - 9 'software program').

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanji, in view of Kang et al. (United States Patent Application Publication US 2001/0038032 A1), hereinafter referenced as Kang.

Regarding **claim 3**, Tanji discloses everything claimed as applied above (see claim 2), in addition, Tanji discloses that the sequence data or "identification information" has a fixed storage capacity available (page 6, paragraph [0037], lines 16 – 20, and figure 5). However, Tanji fails to disclose that although a fixed storage capacity is available "when any piece of identification information exceeds a predetermined length, the control unit is operable to store the piece of identification information reduced to the predetermined length". The examiner maintains that it was well known in the art for the method and apparatus for storing audio data disclosed in Tanji to include "when any piece of identification information exceeds a predetermined length, the control unit is operable to store the piece of identification information reduced to the predetermined length", as taught by Kang..

In a similar field of endeavor Kang discloses the truncation of a file name to achieve a fixed 8.3 format (page 13, paragraph [0186] lines 1 -5) which reads on "when any piece of identification information exceeds a predetermined length, the control unit is operable to store the piece of identification information reduced to the predetermined length" claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and apparatus for storing audio data of Tanji by specifically using the teachings in Kang to include "when any piece of identification information exceeds a predetermined length, the control unit is operable to store the piece of identification information reduced to the predetermined length" because one having ordinary skill in the art would want to raise the efficiency of implementation (Kang, page 12, paragraph [0184], and lines 1 - 3).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN BUTCHER whose telephone number is (571)270-5575. The examiner can normally be reached on Monday – Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young, can be reached at (571) 272 - 7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/TAN Xuan DINH/
Primary Examiner, Art Unit 2627
September 25, 2008

BMB
September 24, 2008

